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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,335	08/04/2003	Jean-Marc DuFour	DRXI-0144	6769
23377	7590	03/01/2006	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR 1650 MARKET STREET PHILADELPHIA, PA 19103			JONES, DAMERON LEVEST	
			ART UNIT	PAPER NUMBER
			1618	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/634,335	Applicant(s) DUFOUR, JEAN-MARC	
	Examiner D. L. Jones	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/23/05.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18,20-29,31 and 34-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18,20-29,31 and 34-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO APPLICANT'S ARGUMENTS

1. The Applicant's arguments filed 11/23/05 to the rejection of claims 1-18, 20-29, 31, and 34-36 made by the Examiner under 35 USC 112 have been fully considered and deemed non-persuasive for reasons of record in the office action mailed 8/24/05.

Note: Claims 1-18, 20-29, 31, and 34-36 are pending.

112 First Paragraph Rejections

The rejection of claims 1-18, 20-29, 31, and 34-36 under 35 USC 112, first paragraph is MAINTAINED for reasons of record in the office action mailed 8/24/05 because the specification, while being enabling for Compounds 1-33 as set forth in the specification comprising a chelating moiety, does not reasonable provide enablement for all compounds as set forth in independent claims 1, 9, and 16 wherein R1 is a protective agent; R2 is an activated ester, a carboxylic acid, and alkyl isothiocyanate, an aromatic isothiocyanate, or a leaving group, and R3-R5 are protective groups.

In summary, Applicant asserts that there is not reason to believe that those skilled in the art would not be able to practice the claimed invention.

Applicant's argument is found non-persuasive for the following reasons. Applicant is reminded that an inventor must describe the item to be patented with such clarity that the reader is assured that the inventor actually has possession and knowledge of the unique composition and uses thereof worthy of patent protection. Thus, in order to practice the instant invention, one of ordinary skill in the art would have

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to engage in undue experimentation with no assurance of success to determine which species possess the necessary characteristics of Compounds 1-33.

112 Second Paragraph Rejections

The rejection of claims 1-18, 20-29, 31, and 34-36 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention is MAINTAINED for reasons of record in the office action mailed 8/24/05.

Applicant asserts that the preamble of each claim is directed to method of administering or detecting compounds and that Applicant is not required to further limit the scope of its claims since a skilled practitioner in the art would have no difficulty understanding the metes and bounds of Applicant's claims in light of the disclosure.

Applicant's arguments are non-persuasive for the following reasons. First, the claims do not set forth the method of interest. Compounds may be administered for an unlimited number of reasons (i.e., cancer treatment, detecting cholesterol levels, understanding renal function, imaging coronary tissue, determining whether a subject is diabetic, for controlling the coughing associated with a cold, etc.); thus, a method of administering a compound does not set forth the reasoning for why the compound is being administered. Thus, in Applicant's method claims it is unclear why the compounds are being administered and detected in a subject.

In addition, the rejection over the claims is being maintained because it is unclear what protective groups, activated esters, carboxylic acids, alkyl isothiocyanate,

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aromatic isothiocyanate, and/or leaving groups that Applicant intend to be compatible with the instant invention and possess the characteristics of those of Compounds 1-33.

COMMENTS/NOTES

2. It is once again noted that no prior art has been cited against the instant invention. However, Applicant **MUST** address and overcome the 112 rejections above. The claims are distinguished over the prior art of record for reasons of record in the office action mailed 3/8/05.


3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

February 21, 2006